

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Patent Application of
Diane Saccomandi

Application No.: 10/620,141

Filed: July 15, 2003

For: DECORATIVE TABLE COVERING

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: Examiner: Alexander S. Thomas
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: Art Unit: 1772
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TRANSMITTAL FOR APPLICANTS' APPEAL BRIEF

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Also Enclosed: Fee Transmittal Sheet (in duplicate)
 Postcard receipt

FEE TRANSMITTAL

Application Number: 10/620,141

Filing Date: July 15, 2003

First Named Inventor: Saccomandi

Group Art Unit: 1772

Examiner Name: Alexander S. Thomas

Total Amt of Payment (1) + (2) + (3) = \$250

Attorney Docket Number: 1367-P03250US00

METHOD OF PAYMENT (check one)

The Commissioner is hereby authorized to:

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FEE CALCULATION

1. FILING FEE

Fee Description	Fee
Utility filing fee	
Design filing fee	
Plant filing fee	
Reissue filing fee	
SUBTOTAL (1)	\$0

2. Claims Fees

# of Claims - Paid	Extra Claims	Fee/Claim	Fee
Total Claims 20-24 =	0	25	\$0
Indep Claims 1-3 =	0	100	\$0
Multiple Dependent Claim Fee			

SUBTOTAL (2) \$0

ADDITIONAL FEES

Fee Description	Fee Paid
Surcharge-late filing fee or oath	
Surcharge - late provisional filing fee or cover sheet	
Extension for response within month	
Notice of Appeal	
Filing a brief in support of an appeal	250
Request for oral hearing	
Petition to revive unavoidably abandoned application	
Petition to revive unintentionally abandoned application	
Issue Fee	
Petitions to the Commissioner	
Petitions related to provisional applications	
Submission of Information Disclosure Stmt.	
Recording each patent assignment per property	
Other fee (specify) <u>Advance Order (10 copies)</u>	
SUBTOTAL (3)	\$250

Submitted By: John C. Dorfman Reg. Number 16,703

Signature *John C. Dorfman*

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: : Group Art Unit: 1772
Diane Saccomandi :
Serial No.: 10/620,141 : Examiner:
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APPLICANT'S APPEAL BRIEF

INTRODUCTION

This appeal is from the Primary Examiner's final rejection, dated May 20, 2005, in the above-identified patent application. Notice of Appeal was filed on July 22, 2005.

1. REAL PARTY IN INTEREST

The real party in interest is the named sole applicant Diane C. Saccomandi of Folsom, Pennsylvania. Applicant has neither licensed or assigned all or any part of the pending application or the invention thereof.

2. RELATED APPEALS AND INTERFERENCES

Applicant does not know of any prior or pending appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

3. STATUS OF CLAIMS

The applicant retains the original claims 1, 9 and 11-24, with amendments to claims 1-3, 5, 7, 8, 12-16, 19-24 before final on March 2, 2005. Applicant seeks to cancel claim 10 for the reason specified in discussion of that previously uncanceled claim. After the final rejection dated March 25, 2005, the applicant on May submitted the same claims as previously amended with an additional minor amendment to claims 4 and, as suggested by the Examiner, offered to substitute independent claims 25, 26, 27 and 28 for allowable dependent claims 5, 8, 15 and 16.

Since the Examiner did not enter the claims, or even specifically approve their form, the applicant has not included claims 25, 26, 27 and 28 in the attached claims history Appendix. In

their stead, because the applicant is uncertain of their status, she has included the original dependent claims which were offered to be cancelled subject to entry of the independent claims but which offer was rejected by the Examiner. While the Examiner did not withdraw allowability he conditioned the allowance of the four new substitute independent claims upon cancellation of all rejected claims. Thus the only allowable claims entered of record are the dependent claims enumerated. They will be retained until their status is clarified and have been commented upon briefly in passing.

A new independent claim 29 and new dependent claims 30-32 dependent therefrom were proposed for entry because it was hoped from discussion at the interview that the Examiner would also consider these claims generally of the scope of the allowable claims and permit them to be entered. A new claim 33 was also added which affirmatively claimed a table having a selected shape and size of the table top as well as other limitations of claim 1. The new claims were proposed as a result of the telephone interview with the Examiner in which the Examiner suggested that claims of the scope of the new claims submitted might be allowable.

It was in the Examiner's advisory action on June 21 he conditioned allowance of claims 25-28 on cancellation of all rejected claims.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1

Applicant's invention as recited in claim 1 relates to a decorative table covering. A fabric cover, generally corresponding to the shape of a table top with which the decorative table covering is to be used, but smaller than the table top so that, when placed on the table top, it will expose parts of the table top or any covering thereon beyond the peripheral edges of the fabric cover. The purpose, of course, is to allow the beauty of some of the wood grain and finish of the table top to be exposed, or alternatively, if the table has been covered with a decorative undercover, to allow the color or pattern or other feature thereof to be viewed around the edges of and contrast with the fabric cover. Loop extensions on the fabric cover extend periodically from the periphery of the fabric cover to the edge of the table top where they provide support loops for ties to be spaced from the periphery of the fabric cover. At least one decorative tie is to be fed through the loops and around the table top in a decorative way. This permits a single tie or multiple ties in series to be used. In either case the adjacent ends of the tie or ties are connected together in a decorative way between adjacent loop extensions. No prior art, including that cited herein, shows a decorative table cover in which the cover leaves exposed the table around the edges of the fabric cover and no cited references suggest a decorative use of its illustrated or described structure.

The purpose of the applicant's invention is to provide a cover structure for festive occasions when the table and the decorative table covering become a display of added beauty. The decorated table may be simply used without further functional purpose on some occasions. Either way it provides a decorative effect. The loop extensions themselves, also preferably provide part of the decorative effect and further contribute in a functional, yet decorative way. The loops function to support the tie or ties fed through the loops around the edge of the table top. If a single tie is used, its color, texture, draping, connections and other decorative aspects add to the display. Since the tie is primarily decorative it may be draped or arranged between the loops to add to the effect. The tie has its adjacent ends connected together between the loops with a bow or some other decorative fastener. The choice of using multiple ties to provide more than one decorative connection allows for symmetrical arrangement of the ties and enhancement of display. The overall combination of components and parts contributes to the beauty and decoration as a whole. The decorative arrangement allows many variations of attractive materials for the ties and also for the means connecting them together at the ends of the ties in

a decorative way. The prior art has not provided such a decorative combination, particularly one which allows many ways in which it can be used and altered for decorative purposes.

Many people have a prize table which has beautiful wood grain or ornamentation on the top of the table. The usual practice in using any kind of table is to cover it completely so that the beautiful features of the table are completely hidden. Applicant's invention addresses the need for more versatile decorative use of a table and supplies a product which has not been available. She believes that in offering the public her invention, it will find a ready market. It should be noted in passing that this invention has nothing to do with keeping the table surface clean. In fact, the table may not even be used for serving food when it serves as a decorative piece. The invention also has nothing to do with tying the table covering onto a table to prevent it being blown away by wind. It has to do entirely with decorative effect. No individual cited patent, nor any combination of cited patents, shows or suggests the applicant's decorative table cover.

Claim 2

Claim 2 which is dependent from claim 1 merely provides a specific preferred form for positioning of the fabric cover in the middle of the table top and the cover is a set shape and size that it does not extend to the edge of the table top except to the extent portions providing loop extensions do so. While claim 1 allows other arrangements such as an eccentric placing of the covering on the table, claim 2 covers undoubtedly what would be the most popular form of a novel table covering, placing it in the middle so that the wood or design of the table beneath it can be seen equally well all around the central covering. Such a decorative covering has not been found by the Examiner in his searching in a single prior art patent or any combination thereof.

Claim 3

Claim 3 adds to claim 1 a new feature in which at least part of the fabric cover is perforated in a decorative design to expose the table top or cover thereon beneath the fabric cover. An example is the decorative design of Fig. 7 which shows the table covering having a single large perforation 26 of the same rectangular shape as the table covering.

The specification paragraph T0024, beginning on page 10, addresses some of the possibilities of other forms and styles of cut-out. In the last two sentences on page 11, it

suggests multiple openings as well as other symmetrical or asymmetrical cut outs or patterned fabric having cut outs or hem applied as patterned decorative applies.

The Examiner has cited no prior art showing no reference which shows or suggests such ornamentation. The Examiner has ignored ornamentation.

Claim 4

Claim 4 is dependent from claim 3 and adds that the perforated area of the fabric cover has perforations which cover and allow viewing another contrasting fabric through the cut outs. There are no cited references that show or suggest this specific type of decorative structure.

Claim 5

Allowable claim 5 dependent from claim 4 but was requested to be replaced by independent claim 25. This claim adds to the perforation in the cover, exposing contrasting fabric, which contrasting fabric also has openings which enable the table top, or still another covering beneath the contrasting fabric, to be seen. The Examiner agrees the claim is patentable over the cited prior art and stated the claim would be allowable if put in independent form but refused to enter the substitute independent claim and the other allowed independent claims he had suggested without cancellation of all rejected claims.

Claim 6

Claim 6 is dependent from claim 1 and directed to the additional feature of at least part of the fabric cover being non-woven fabric. There is no cited prior art, showing or suggesting this combination.

Claim 7

Claim 7, also dependent from claim 1, takes a new tack and calls for the ends of decorative ties to be pulled together through the loops of the extensions and tied to each other in a decorative manner, such as in a bow as shown in the drawings. The Examiner has found references showing functional drawstrings on picnic table covers and seat covers and insists that they are the functional equivalent to decorative ties, but the Examiner has found no ties that perform applicant's decorative purpose. Instead some reference ties serve a specified functional purpose when pulled tightly to hold the table cloth or seat covering in tight conformity with the

shape of the structure to serve the purely functional purpose of holding the protective covers in place. No decorative effect is shown or described or suggested in any reference.

Claim 8

Claim 8 (like claim 5) was indicated allowable if rewritten in dependent form and independent claim 26 was submitted to be substituted for it. This claim adds to claim 1 that the ends of the decorative ties are connected together by some other decorative means other than the ties themselves. No such combination is shown in the prior art, as the Examiner has recognized.

Claim 9

Claim 9 is also dependent on claim 1, also focuses on the ties, and provides that they are made of material different from the fabric cover. The ties 22 might be draped red velvet and the fabric cover white linen, to give one example. The draping and decorative arrangement of ties is shown in the drawings and described in the specification. No such decorative combination is shown or suggested by the cited prior art.

Claim 10 - is being cancelled

Claim 10 is directed to the table covering of claim 1 in which the ties are specified to be a different color from the fabric cover. While it is true that no such color differences are shown or suggested in the cited prior art, it is appreciated that color alone is not sufficient basis for patentability.

Claim 11

Claim 11 changes the area of focus to the loop extensions and specifically provides for a decorative table covering of claim 1 in which the loop extensions are separate pieces from the fabric cover and attached to the fabric cover. This, of course, permits the extensions to be different from the table covering for further decorative effect through diversity. Figs. 8a and 8c show examples. No such combination is found or suggested in the prior art.

Claim 12

Claim 12 is dependent from claim 11 and provides that each loop is formed by folding back the loop extension on itself connecting one end of each extension near the other and

connecting the other end of the extension to the fabric cover. As seen in Fig. 8a extension 32 is often a separate piece attached to the table covering and the loop is formed using the type of folding back claimed and connected to itself on the underside as seen in Figs. 8a and 8b or on top as in Fig. 8c. There is nothing in the cited prior art to show or suggest extensions for the applicant's decorative purpose provided, or for any purpose.

Claim 13

Claim 13 adds to the structure of claim 12 making specific that in this embodiment the back end of the loop is attached at the top only part of the way from the periphery to the fabric cover to which the other end of the extension is attached and the loop is fixed to itself as shown in Fig. 8c by decorative means 40, which may be some sort of separate fastener. Such a fastener is not seen or suggested in any cited prior art for any purpose. Separate pieces attached to fabric cover, if used, are not decorative not of the specific construction described, nor is any structure in cited references intended for decorative use.

Claim 14

Claim 14 is also dependent on claim 11 and provides that the loop and the extension is formed by rolling the free end of the extension in to a loop as seen in Fig. 8b and connecting to the contacting parts of the loop together and the free end of the extension to the fabric cover. The cited references show no such detail in any form, and particularly not as decorative detail.

Claim 15

The allowable claim 15 is also dependent from claim 11 and provides for a loop formed in at least one loop extension by connecting the end of the extension together by a decorative connector with a decorative side of the connector visible. Such a connector is decorative fastener 40 as seen in Fig. 8c. This claim was found allowable by the Examiner and rewritten as independent claim 8 as suggested by the Examiner, but was not entered.

Claim 16

Claim 16 is directed to a decorative table covering of claim 1 and having at least one loop extension provided with at least one decorative cut-out 28' through its fabric as shown in Fig.

8a. Such a decorative feature was neither shown nor suggested in any of the prior art references cited.

Claim 17

Claim 17 is the decorative table covering of claim 1 in which its loop extensions are an integral part of the fabric cover as shown in Figs. 1-3. None of the prior art references suggests anything like this decorative arrangement.

Claim 18

Claim 18 is a decorative table covering of claim 1 with loop extensions which are individually decorated. Such decoration may be cut outs, embroidering or other decorative embellishment. The prior art cited has nothing to do with such decorative features and suggests nothing about decorative use, much less the structural detail described.

Claim 19

Claim 19 provides for a decorative table covering of claim 1 in which the fabric cover corresponds in shape to the table top shape with which it is intended to be used, but is smaller in size than such a table top. Specifically the same shape for the fabric cover as for the table is a generic step toward the following claims to specific shapes. Such fabric covers are not shown in the cited references in which instead all table covers extend beyond the table top edge.

Claim 20

Claim 20 provides a structure of claim 19 with generally circular shape for the fabric cover, the shape of a table top for which it is intended, but smaller in size to expose the table top around the fabric cover. None of the references shows a round table covering for a round table larger than the cover to expose the table top beyond the edges of the cover.

Claim 21

Claim 21 provides that a decorative table covering of claim 19 is for a rectangular table top with the fabric covering being generally of rectangular form but smaller than the table top of a table with which it is intended to be used. No such combination is shown or suggested by the prior art.

Claim 22

Claim 22 provides that a decorative table covering of claim 19 is for a generally square table top wherein the fabric covering is the same generally square shape but smaller than the table top of a table with which it is intended to be used. No such combination is shown or suggested by the prior art.

Claim 23

Claim 23 is dependent on claim 1 and further defines the decorative table covering by providing that when placed on a table top of a size for which it has been made, the loop extensions will extend to and beyond the edge of such a table so that the ties, when installed through the loop extensions, will fall below the table top with the effect of holding the decorative table covering in place. This is an admission that the ties in some configuration can have some functional holding effect, but it does not diminish the primary decorative effect of the appearance of the table covering as a whole, which is its primary purpose and clearly distinguishes it from cited art. It should also be understood that the decorative effect is best when the fabric cover is centered and having the ties for the sash extend beyond the edges of the table can help hold the decorative covering in its intended position which in itself enhances the decorative effect. But the purpose is primarily to achieve a decorative effect rather than, for example, holding a picnic table cloth in place against wind trying to blow it off the table.

Claim 24

Claim 24 is dependent from claim 23 but adds a further lengthening of the extensions. It also provides that, when pulled sufficiently tight, at least some part of them lie under the table top. This is particularly intended for a specific application in which a decorative undercover is advantageously used so that, in addition to the draping effect of the ties, the undercover may also be pulled somewhat inward for effect and changing the way the undercover falls from the table edge. No such a decorative combination and effect is shown or suggested in the cited prior art references.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The final rejection dated March 23, 2005, there are four claim rejections based on 35 U.S.C. §102 (b). They are all to the effect that, whatever the reference, the argument concerning the drawstring being functionally different from applicant's decorative ties were deemed not persuasive. In each case, each of the references in turn were said to anticipate various claims of the opponent's application which will be enumerated below. In each case it was said that the intended use that the instant claimed tie does not structurally distinguish it over the strap, loops or string of the prior art article. The argument in essence was, the appellant's tie, or ties connected in series, are fed through loops on extensions from the small fabric covering so that they will be able to effectively reach or extend beyond the edge of the table. The extensions are spaced apart for the purpose of exposing the table beyond the fabric covering. The ties are arranged close to the edge of the top for the same reason: to expose more of the table top. The ties can be passed through the supporting loops at the end of the extensions and are composed of a decorative material preferably made more striking due to color, texture or the kind of material used. But in every case, the appellant's tie is decorative, employed to extend through the loops in a decorative way, which might be called festooning, at or near the edge of the table. Preferably the ties are loosely hanging as opposed to being used in primarily function way, as the reference use them in every case. A table cloth and a seat cover use a tautly pulled drawstring to hold the cover on the table. The other two table covers are convertible to trash bags and the drawstring are used to gather the cover into a trash bag. It makes no difference what the material of the drawstring is, it simply has to be capable of supplying by tension the force used to hold a cover in place or draw the cover into a trash bag. Some references use a thin rope or tape which serves to pull parts of the cover, whether for a table or chair, over the structure. The others ignore the drawstring while the cover is on a table. Any decorative function is absent and must not interfere with pulling or tension to tighten the cover against the table top or chair, etc. None of the reference structures is intended to be decorative, but as plain and utilitarian as they can be, to keep the cost low. The Examiner responded in final rejection that "Concerning the discussion of the drawstring, the intended use of the instantly claimed tie does not structurally distinguish it over that of the strap loop or string of the prior art article." All references were used independently of one another for the 102(b) rejection and the claims involved in the rejection are as follows:

Rodenbaugh et al.: Claims 1, 2, 6, 7, 9, 11, 12, 14, 17 and 19-24.

Schaub et al.: Claims 1-4, 17 and 19-24.

Bonnett: Claims 1, 2, 6, 9, 12, 13, 17 and 19-24.

Neilson: Claims 1, 2, 7, 9, 11, 14 and 17-24. Neilson may be argued to have inherently decorative properties because of the sheep skin. His covers are held in place by being laced together. The drawstring is laced like a shoestring through opposed parts of each piece attached to the covers to draw them together and hold the covers tightly onto the seat parts. Nobody intentionally makes a commercial structure to be ugly; but only Neilson, a non-table cover reference, keeps the extensions and lacing simple and out of sight instead of, for example, including a decorative sash as a tie to make it decorative and attract attention, as the appellant has done.

Some or all of the references were used to reject at least some of the claims, in particularly, 1, 2 and 19 because “the cover size relative to a table does not distinguish over the prior art, since the table may be any size, the cover may be any size.” However, the structure, the table covering is described in terms relative to any size of the table top it may be made to be used with.

35 U.S.C. §103 (a) is used to reject claim 10 as obvious over each of the references Bonnett, Neilson, or Schuab et al.

Claim 10 has been cancelled to avoid consideration of a less significant collateral issue: claim 10 made a distinction strictly on the basis on the color in which ties are a different color from the fabric. Color, per se, is normally not a basis for patentability but in a situation where what is claimed is a decorative combination employing a fabric cover and extensions of different color produce a decorative effect, it should be given more weight. Color assumes an importance in decorative displays and the like, which would not be present in other structural combinations. However, such a collateral issue may await consideration on another occasion.

7. ARGUMENT

Appellant has chosen to proceed with appeal of the claims in this case because she believes that her decorative table covering is an invention worthy of patent protection. It almost seems as though there is some prejudice against protecting an otherwise patentable structure solely because it is decorative, although that has nowhere been suggested by the Examiner directly.

In the broadest terms claim 1 is directed to a decorative table covering which comprises 3 cooperating components:

The first component is a “fabric covering” which in claim 1 has been defined as being “smaller than a table top” for which it is made in order to expose the wood, or decoration of the table top. This limitation is present in all claims on appeal. (In claim 2, the fabric covering is effectively located in the center of the table top in what the appellant believes will be the preferred structural configuration.)

The second component is “loop extensions periodically extending from the periphery of the fabric cover to the edge of the table top” so as to leave the table uncovered. The loop extensions provide loops for a decorative tie to be spaced from the periphery of the fabric cover. The loop extensions may be the same fabric as the fabric covering or may be separate pieces attached to the fabric covering and, like the fabric covering itself, subject to decorative treatment. The loop extensions, functionally provide loops for supporting the third component, the “decorative tie around the periphery of the table.”

The third component, the decorative tie, may be in one piece or multiple pieces connected together end to end. Claim 1 calls for “at least one decorative tie to be fed through the loops around the table top in a decorative way and so that each pair of adjacent ends of the tie or its pieces may be connected together in a decorative way between the loop extensions.” The ties in this case might perhaps have been better categorized as a sash. Whether there is one piece or multiple pieces in series, the ends of the adjacent piece or pieces are connected together by a bow or a decorative device, a subject of dependent claims.

Comparing the drawings of the application on appeal and the references cited, it is obvious on its face that the applicant has in mind something entirely different from any of the references cited. There seems to be two major problems that have been variously expressed but come down to this:

1) The term “decorative” is being ignored because the Examiner believes it is too general and indefinite.

2) The table is not claimed but somehow referred to and the Examiner says it is improperly inferentially included. Alternatively he says it is indefinite because exact size of table and shape of the table and of the decorative components themselves are not claimed.

“Decorative” is used here in a broad sense but is not indefinite. A generic term is called for in describing a connector for ties because there are so many different attractive ways of connecting the ties together. But “decorative” is also used to distinguish tie structure used primarily in the utilitarian sense of holding things together. Only a small number of examples of connectors have been mentioned in the specification but they are illustrative of the scope of protection to which the appellant is entitled. However, the fact that the individual components or parts of the inventive combination are decorative is not the whole consideration. Additionally, the combination of the components together as a unit is decorative.

All of the components claimed must be used structurally, but not all of them need to be decorative in all applications, but possibly may need to be specially decorative in some way on a particular occasion. Either way their use and arrangement as a whole is intended to be decorative.

The size of a table used does not matter. The invention is broad enough to encompass great variation and size and shape of tables. What is important is that the structure created does not cover the whole table top. The fact is that the decorative covering would either have to be custom made to fit a particular table or, more likely in a commercial setting, be made and stocked in a whole range of sizes and shapes to be available for tables of different sizes and shapes. But that the claims must allow relative sizes and shapes certainly should not be the basis of any legitimate objection. By having a fabric cover smaller than the table top, whatever its size assures that all of the table will not be covered. Neither do the loop extensions cover the table because they are defined as “periodically extending from the periphery of the fabric cover to the edge of the table top.” Perhaps the inferentially understood fact that the configuration should remain such that major parts of the table top are exposed should be repeated in connection with the loop extensions. But the whole application makes that clear as the primary object of the invention, and the specification and the drawings confirm that the purpose of the invention is to display the table top. Furthermore, it is clear that the loop extensions are positioned so that the loops for the ties are spaced from the periphery of the fabric cover for the purpose of the

exposure of the table top and to display the beauty of the wood of that structure or its decoration in some way.

The decorative tie location is defined by position of the supporting loops “spaced from the periphery” and by express limitation the tie is “fed through the loops and around the table top,” and “spaced from the edges of the fabric cover.”

The claims make clear that the purpose of the appellant’s structure is to allow the table top or other decoration on the table to be seen with the decorative cover in place. This is not permissive, it is the reason for being. The decorative display of the table top through the covering, clearly sets the present application and its claims apart from any references that have been cited by the Examiner. The appellant’s concept, of large areas of a table being left uncovered necessitated by the structure as claimed is clearly lacking in each of the references cited. The references cited are utilitarian devices, which incidentally could be colored or decorated in some in way, but which do not show the appellant’s determination to display the table surface in an appealing and decorative way by providing appropriate structural parts.

What all the references have in common is a drawstring or tie usually placed in a hem around the fabric cover and in each case is used either to be drawn tight around the protected surface or to close the cover into a bag after use. The references relating to table cloths rather than displaying the table top make every effort to cover the whole top as completely as possible, some cases it does double in forming a trash bag. The draw string may pull the cover tight up against the table, in which case the tie is intended to hold it on the table against the wind. In the auto seat cover reference, the purpose is to draw the cover tight around the front of the seat to protect the front of the seat where a passenger would be sitting and riding and also make it more comfortable. Any exposure of the drawstring is not intended to be decorative but is quite functional in helping to allow access to the tie to pulling the draw string tight. Table covers may avoid problems at the corners by cutting away part of the table cloth that is not intended to cover the table so that the path of the hem support for the tie is reduced to closer to that of the length of the tie.

There seems to be some suggestion that the applicant does not specify particular size or shape for the table. Such matters are not significant in patents. Actual size, presumably can be varied. The only kind of situation when dimensions are given or suggested is in connection with such things as clearances of moving parts or other critical dimensions that may have some functional purpose for limitation. Of course, requiring an applicant to claim a table or mobile

seat or other structure with which a particular invention is used defeats the value of a patent by requiring such environmental structure to be claimed.

Claims 1 and 2 are the only claims which have been mentioned. All claims are dependent from claim 1 directly or through other claims. The Examiner has found allowable four claims as a practical matter. These four claims would give the appellant worthless, easily avoided claims. Other dependent claims have been distinguished here as the claims were described and because of differences clearly are not anticipated on a 35 U.S.C. §102 basis and have not been rejected on a 35 U.S.C. 102(b) and 35 U.S.C. 103(a). The Examiner has given no basis for rejecting such claims as wholly anticipated. At least some of these claims are at least as worthy of allowance as the claims the Examiner has chosen to allow.

8. Consideration of Individual References Relied Upon

A.) Rodenbaugh et al. patent number 4,705,084. The Examiner relied upon two figures that show the underside of tables with two different configurations. Both of these figures show tensioning means used to pull the picnic table cover tight around the top of the picnic table. Neither one of these views shows that the picnic table is entirely covered. Therefore it cannot anticipate an invention directed to leaving the table top decoratively exposed by the nature of the claimed structure. Moreover, appellant's decorative ties are never not pulled tight under the table for tensioning because their decorative purpose requires them to be exposed around the edges of the table top. Figs. 2 and 18 show that the hem and loops used to tension the table are kept beneath the table top out of sight. The fabric cover in this reference generally corresponds to the shape of the selected table top, but certainly is not smaller than that top as claim 1 of the appellant's claim provides. When placed on the table top, none of the table top as seen in Fig. 1, the appellant's drawings show the decorative tie clearly visible from the top of the table. The reference shows no decorative tie fed through loops around the table top in a decorative way. Using Rodenbaugh's tensioning, the ties are instead kept out of sight. Clearly there is no way that the ends of ties may be connected together in a decorative way between the adjacent loop extensions. Appellant's drawings and specification suggest decorative connections, but there would be no purpose to having decorative ties or decorative connections of the adjacent ends of ties hidden beneath the table. Rodenbaugh et al. clearly does not illustrate and describe the decorative table covering claimed by the applicant. Nor is there anything in the specification that suggests such decorative pieces or uses as described and shown by the appellant.

B.) Schaub et al. patent number 4,895,742. Fig. 7 and cited text in column 2, lines 21-44, does not relate to a decorative table covering of any sort. Instead, Schaub et al., which is referred to as a “convertible receptacle” shows cover when used as a table cover, covers the entire table top. It shows a continuous functional draw string exposed periodically around the edges through slots 8. The exposed areas are at the corners and at the center of each side of what is shown as a square table to facilitate tie access and use as a drawstring for the container. Fig. 8 shows how the table covering is drawn together and picked up to contain the paper cups and dinner utensils, referred to as “refuse” or “debris 13” left on the table top portion and collected within the container using draw string 8. Fig. 6 makes clear that the draw string members at the middle of the table sides are also to be used in the same way and for the sole purpose of pulling the cloth, now a trash bag, into the trash bag mode. The top of the table is completely covered at all times of use as a table cloth. The entire draw string is a single piece around the table cloth, apparently manufactured in one continuous loop, so that there are no connections of any kind, decorative or otherwise. While used as a table cloth the drawstring is in the position shown, short lengths of the tape are exposed along the edges of the table where they pass through the slots, whether they are on the corners or the sides, but no suggestion is made of decorative purpose and they pass through the slits in the hem of the main body of the cover so that there is no decorative loop extension as in that applicant’s structure. Certainly there are no decorative details at the places where the functional tape is exposed.

C.) Bonnett patent number 5,069,554 again has a cover which is shown covering the entire table. Indeed the concern for spills is shown in Fig. 1 where the spill 2 is contained within the raised border area 2. The raised border area provides a number of open areas 3 which expose a cinch strap 4 which appears to be continuous. The raised border is not decorative, but obviously functional. If raised to any significant height, the raised border amount would be counter-productive to people trying to eat food or drink. Apparently the cinch strap is not used in the table cover mode at all, but is pulled from its exposed positions to close the table cover into a bag. There are obviously no areas exposing the table top during the use of the table as shown in Fig. 1 or elsewhere. Since the table cover covers the whole table, there are no need for extensions for the loops such as the appellant uses. The cinch strap is confined in a modified tube which is very much like a hem at the edge of the table cover and directly attached to it the cover as shown in Fig. 5. Bonnett is purely functional and may provide a utilitarian article for

a picnic and trash disposal in one structure, but there is nothing decorative about it and it lacks the required structure for the appellant's claimed decorative display. It has no loop extensions from a smaller fabric center piece. The cinch strap appears to be a continuous piece so there is no need at all to tie it together or connect it either in any decorative or functional way when it is around the table.

D.) Neilson patent number 4,396,227. The inventor is from Australia and provides a way of applying a sheep skin cover to an automobile seat and its back. Fig. 1 shows that the sheep skin is intended to be conforming to both the seat and back and extends around to the back side of each part. Behind the back there are loops to contain and guide the straps which pulls the covers tightly into conformity with the seat in the back. The straps are not intended to go around the entire back of the structure but made in pieces with connectors 9 and 22 holding them together and some intermediate pieces. In addition, out of view and away from functional body contact are woolen extensions of the sheep skin which ultimately terminate in tubular guide hems for the tensioning straps. All functional parts are kept out of sight beneath the seat and kept as plain and unnoticeable as possible on the backside of the seat back.

Nielson's seat is no table, nor even a covered bench as shown in Rodenbaugh. But like each of the other references, the top or exposed surfaces that are meant to be seen and functionally used by the passenger extend all the way to the edges and beyond. There are no decorative openings to supply a view of the fabric of the seat and its back. In fact, failing to cover the whole body contact surface would detract from the highly desirable functional purpose of the seat covers. Any decorative effect in the structure comes from the nature of the sheepskin. Neilson's connecting and tensioning straps and structure have a functional purpose of pulling the covers tightly onto the supporting structure, which is completely lacking in the appellant's structure. There is no decorative aspect to the connection of the ends of the sections of this strap, but purely functional connectors 9 and 21 employed are kept small and kept out of sight to the extent possible. The need for functionally applying tension to the covers is apparent. Nothing in this patent resembles the applicant's decorative table cover and it seems inappropriate to apply a 35 U.S.C. 102 rejection to the applicant's claims based upon this patent no matter how interesting and creative it may be.

The references, as a whole, represent a highly contrived collection of patents which truly do not respond to the appellant's claims, both in the overall purpose thereof and in the detailed elements thereof.

There is another important point, the Examiner consistently uses 35 U.S.C. §102(b) as though each reference without more shows the appellant's invention. Where as here, the rejected claims do not completely describe the same structure as shown and described by each reference, it is incumbent on the Examiner to explain why the differences would occur to one skilled in the art. The Examiner does not give reasons why differences would be obvious. One reason is that it is not obvious at all. In fact, the appellant's configuration differs radically in appearance from any reference. Of course, that difference appears in what the invention is all about and there is nothing obvious about it. Explanation alone has to show some considerable basis, not the Examiner's gut feeling. Gut feelings may be appropriate for an art critic. One may or may not like or find attractive a particular combination. This invention permits so many different combinations that almost any taste might be satisfied. The problem here is that to reject one reference is not sufficient by some variation. One is any combination because they teach repetitive lessons. The Examiner in this case should have found a 35 U.S.C. §103 combination, but he could not. But in failing to give proper reason why any of the references under the invention is obvious he trivializes the differences, as if to say they are not important. That is not enough under the law, and it certainly is not fair treatment of this appellant's invention. In this case, the Examiner has erred by not completing the statutory requirement. He has not shown why beyond the references he has cited, the invention would be obvious to a person skilled in the art.

Conclusion

Issues involved in this case may be difficult to frame or very easy to frame. The following are a list of issues but they are placed in the conclusion rather than in a special heading for issues because they seem to be better considered after the full discussion of the above brief.

Are claims directed to a structure whose function is primarily decorative display per se unpatentable?

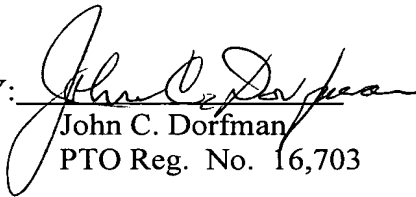
Are claim limitations directed to decorative effect entitled to consideration as distinguishing structural features, where the meaning of such limitations are shown in drawings and described in the specification?

Are structural details claimed and specifically shown and/or described in the specification but literally not shown in cited references, capable of distinguishing over prior art cited and rendering a claimed structure patentable?

For the above reasons, the Examiner erred in rejecting claims 1-4, 6, 7, 9, 11-14, and 17-24. There being no proper grounds for rejection, Appellant is entitled to patent protection on the subject matter of the appealed claims. It is, therefore, respectfully requested that the rejections of record be reversed and that the above pending claims be allowed to Appellant.

Respectfully Submitted,

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APPENDIX: CLAIM LISTING

1. A decorative table covering comprising:

a fabric cover generally corresponding to the shape of a selected shape of table top but smaller such that, when placed on such a table top, it will expose parts of the table top, or any covering thereon, beyond the peripheral edges of the fabric cover,

loop extensions on the fabric cover periodically extending from the periphery of the fabric cover to the edge of the table top and providing loops for ties to be spaced from the periphery of the fabric cover, and

at least one decorative tie to be fed through the loops and around the table top in a decorative way and so that adjacent ends of ties may be connected together in a decorative way between adjacent loop extensions.

2. The decorative table covering of claim 1 in which the fabric cover which is placed in the middle of a table top of such shape and size does not extend to the edge of the table top except to the extent portions providing loop extensions so extend.

3. The decorative table covering of claim 1 in which at least part of the fabric cover is perforated in a decorative design to expose the table top or cover thereon beneath the fabric cover.

4. The decorative table covering of claim 3 in which at least one perforated area of the fabric cover has the perforation covered with perforations cover another contrasting fabric.

5. (Cancelled)

6. The decorative table covering of claim 1 in which at least part of the fabric cover is non-woven.

7. The decorative table covering of claim 1 in which the adjacent ends of decorative ties designed to extend through the loops on the loop extensions are pulled together and the ends of the decorative ties tied to each other in a decorative manner.

8. (Cancelled)

9. The decorative table covering of claim 1 in which the ties are made of material different from the fabric cover.

10. (Cancelled herein): The decorative table covering of claim 1 in which the ties are a different color from the fabric cover.

11. The decorative table covering of claim 1 in which the loop extensions are separate pieces from the fabric cover and attached to the fabric cover.

12. The decorative table covering of claim 11 in which each loop is formed by folding back the loop extension on itself, connecting one end of each extension near the other end, and connecting the loop extension as a whole to the fabric cover.

13. The decorative table covering of claim 12 in which the folding back of the end of the loop on the top is only part way to the periphery of the fabric cover to which the other end is attached and the two ends of the extension are decoratively connected together in that position.

14. The decorative table covering of claim 11 in which the loop is formed by rolling one end of the extension into a loop and connecting the contacting parts of the loop together and the opposite end of the extension to the fabric cover.

15. (Cancelled)

16. (Cancelled)

17. The decorative table covering of claim 1 in which the loop extensions are an integral part of the fabric of the fabric cover.

18. The decorative table covering of claim 1 in which the loop extensions are individually decorated.

19. The decorative table covering of claim 1 in which the fabric cover corresponds in shape to a table top shape on which it is intended to be used but is smaller in size than such a table top.

20. The decorative table covering of claim 19 in which a table top on which the covering is intended to be used is circular and the fabric cover is circular but of smaller diameter.

21. The decorative table covering of claim 19 in which the shape of a table top on which the decorative covering is to be used is generally rectangular and the fabric cover is generally rectangular but smaller.

22. The decorative table covering of claim 19 in which the table top shape is generally square and the fabric cover is generally square but smaller.

23. The decorative table covering of claim 1 in which the loop extensions will extend to and beyond the edge of such a table top size so that the ties when installed through the loop extensions will lie outside and fall below the table top so as to tend to hold the decorative table covering in place on the table.

24. The decorative table covering of claim 23 in which the loop extensions are designed to extend below such a table top sufficiently far that the ties when installed may be pulled sufficiently tight to pull at least some part of the ties under the table top.